

REMARKS

The Applicant has studied the Office Action dated July 14, 2004 and has made amendments to the claims to distinctly claim and particularly point out the subject matter which the Applicant regards as the invention. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. Claim 16 has been cancelled without prejudice or disclaimer. By virtue of this amendment, claims 1-15 and 17 are pending. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (3-8) objected to claims 4, 9, 15, and 17 for various informalities;
- (9-12) rejected claims 9 and 15 under 35 U.S.C. §112, second paragraph
- (13) rejected claim 16 under 35 U.S.C. §101 because the claim is directed to non-statutory matter;
- (14-15) rejected claims 1, 3-12, and 14-17 under 35 U.S.C. §102(e) as being anticipated by Kelley et al (U.S. Publication 2002/0174422); and
- (16) rejected claims 2 and 13 under 35 U.S.C. §103(a) as being unpatentable over Kelley et al (U.S. Publication 2002/0174422) in view of Smith et al. (U.S. 6,067,582).

(3-8) Objection To Claims

As noted above, the Examiner objected to claims 4, 9, 15, and 17 for various informalities. Applicant wishes to thank Examiner Roche for the suggested claim language. Claims 4, 9, 15, and 17 have been carefully amended to correct the informalities as suggested by the Examiner. No new matter has been added. Accordingly, in light of the above amendments, the Applicant respectfully submits that the Examiner's objection to claims 4, 9, 15, and 17 have been overcome and the Examiner's objection should be withdrawn.

(9-13) Rejection under 35 U.S.C. §112 and 35 U.S.C. §101

Docket No. POU920010051US1

8

09/896,657

As noted above, the Examiner rejected claims 9 and 15 under 35 U.S.C. §112, second paragraph and rejected claim 16 under 35 U.S.C. §101 because the claim is directed to non-statutory matter. As an initial matter, claim 16, has been cancelled without prejudice or disclaimer. Accordingly, the Applicant respectfully submits that the Examiner's rejection of claim 16 is now moot.

Further, the Applicant has amended claims 9 and 15 for clarity in order to distinctly claim and particularly point out the present invention. No new matter has been added. Accordingly, in light of the above amendments, the Applicant respectfully submits that the Examiner's objection to claims 9 and 15 have been overcome and the Examiner's objection should be withdrawn.

Overview of the Present Invention

Preferred embodiments of the present invention provide a method, computer readable medium and system for the selection, configuration, entitlement, delivery, installation and maintenance of software over a network. The present invention permits customers of an enterprise (e.g., IBM) to "shop" for software from multiple software companies (e.g., a Software House International). Each software company's "ordering system" generates the "entitlement id" for each order (the order is simply for a license, no physical media is shipped to the customer). The entitlement id is sent to the customer over a network, (e.g., via e-mail) and to the software delivery system which runs within the enterprise (in this example, IBM). In one embodiment, the customer must provide a valid entitlement ID before he is allowed to perform the install of the software. In another embodiment, the customer's machine automatically provides the valid entitlement ID to the software delivery server. The entitlement ID is external to the software package. The interface between the software company ordering system and the software delivery application is automated. The software is downloaded with associated scripting controls to ensure that all the correct installation decisions and entitlement keys are used. Unlike prior art systems, the present invention does not require that the client user be involved with any of the installation processes after the initial order is placed. No further user selection or interaction is required after the order

is placed. The system automatically ensures that the entitlement ID used to authorize installation during the order process matches the entitlement ID used to download the software. This prevents unauthorized installation of software. The installation scripts help system administrators manage answers to questions needed during installation which may include one or more product keys. Further, the costs associated with the entitlement for software installation is greatly reduced by the present invention. Instead of creating customized agents and versions of the software, commercially available versions of the software are used with installation scripts. The administrator is responsible for managing these scripts and associating these scripts with a database which includes the order entitlement ID. The package downloaded to the client system includes scripts and any vendor product keys necessary for installation. The present invention provides management and security by ensuring the entitlement ID received on a client system during the order process matches the entitlement ID sent from the same client system during the order process. Again, the system administrator is only required to update entries in the database to match the order entitlement ID with a software package and installation script.

The present invention provides the advantages over the prior art of not requiring modification of the vendor software product. Specifically, this is unlike prior art solutions where the native installation of the software or the behavior of the software after it is installed must be altered. In contrast, the present invention teaches the use of specialized scripts for target client systems. The use of specialized scripts ensures that the software installation is standard across the enterprise. In turn, the use of standardized software along with automated installation reduces help desk costs.

In order to more particularly point out this feature of matching entitlement IDs used during ordering with entitlement IDs used for downloading, where the entitlement ID is used for authorizing the installation of the software file, the following language has been added to the independent claims, i.e., claims 1, 9, 11, 12, 15, and 17 as follows:

- claims 1 and 12

presenting to a user a list of software for installation on a client system;

receiving a user selection for ordering at least one software file from the list of software on a software ordering server;

receiving a response to the order for at least one software file from the software ordering server, the response includes an entitlement ID for authorizing the installation of the software file, wherein the entitlement ID is sent from the software ordering server to the software delivery server;

requesting a download copy of the at least one software file from the software delivery server, the request includes the entitlement ID previously received from the software ordering server;

receiving, in response to the entitlement ID received from the software ordering server matching the entitlement ID received with a request for the download copy, the copy of the at least one software file from a scheduling server as part of a payload containing at least one customized installation script; and

installing the received copy of the at least one software file.

- claim 9

receiving from a software ordering server, an entitlement ID for authorizing the installation of at least one software file which has been previously ordered on a client system;

receiving a request from the client system for the download of a copy of the at least one software file to from the client system, wherein the request includes an entitlement ID used to order the software file;

verifying both the client system's PC compatibility for the requested copy of at least one software file and that the entitlement ID received from the ordering server matches the entitlement ID used to order the at least one software file; and

scheduling the download of the requested software to the client system.

- claims 11 and 15

receiving from a software ordering server, an entitlement ID for authorizing the installation of at least one software file which has been previously ordered on a client system;

receiving a request from the client system for the download of a copy of the at least one software file to the client system, wherein the request includes an entitlement ID used to order the software file;

verifying both the client system's PC compatibility for the requested copy of at least one software file and that the entitlement ID received from the ordering server matches the entitlement ID used to order the at least one software file; and

scheduling the download of the requested software to the client system.

- claim 17

a network interface for coupling at least one client systems;
an order entitlement ID received over the network interface for at least one software file, which has been previously ordered from the at least one client system on a software ordering server;

a download request received over the network interface from at least one of the one or more client systems for a copy of at the at least one software file, wherein the request includes an order entitlement ID for at least one software file;

a database used to store the entitlement ID for at least one software;

receiving a request for the download of at least one requested software file with a download entitlement ID from a client system; and

means for determining if the download entitlement ID matches the order entitlement ID previously stored in the database, and in response to the order entitlement ID matching the download entitlement ID, scheduling a response to the request for a copy of the at least one software file at a scheduling server.

Support for this amendment is found in the present invention at least at pages 4, 9-12 and FIGs. 3-6 of the application as originally filed.

(6-7) Rejection Under 35 USC § 102(e) In Over Kelley

As noted above, the Examiner rejected claims 1, 3-12, and 14-17 under 35 U.S.C. §102(e) as being anticipated by Kelley et al (U.S. Publication 2002/0174422). As an initial matter, the Applicant has submitted an affidavit under 37 CFR 1.131 herewith to remove Kelley. The effective filing date of June 29, 2001 for the present patent application is not more than one year from the filing date of the effective filing date of September 28, 2000 of the Kelly patent application. Accordingly, it is respectfully submitted that the rejection of claims 1, 3-12, and 14-17 under 35 U.S.C. §102(e) should be withdrawn.

Further claim 16, has been cancelled without prejudice or disclaimer and the Applicant submits this renders rejection moot.

Still further, although the Applicant has removed the Kelley reference with the properly filed 1.131 Affidavit, the Applicant provides the following remarks to help distinguish the present invention over the prior art.

In the office action at page 5, with reference to claim 1, the Examiner points to Kelley at paragraph 0050 for teaching an entitlement ID or, in the words of Kelley "A *cryptographic check sums for each file is also included in the patch.*" A cryptographics check sum is also known as a hash value or message digest.^{1 2} The purpose of a hash

¹ From www.whatis.com - A cryptographic checksum is a mathematical value (called a checksum) that is assigned to a file and used to "test" the file at a later date to verify that the data contained in the file has not been maliciously changed. A cryptographic checksum is created by performing a complicated series of mathematical operations (known as a cryptographic algorithm) that translates the data in the file into a fixed string of digits called a hash value, which is then used as a checksum. Without knowing which cryptographic algorithm was used to create the hash value, it is highly unlikely that an unauthorized person would be able to change data without inadvertently changing the corresponding checksum. Cryptographic checksums are used in data transmission and data storage.

² From <http://encyclopedia.thefreedictionary.com> - Product activation is the process through which a product (usually computer software) is activated. Specifically, product activation refers to a method where a software application hashes the serial numbers on a computer and an ID number specific to the license (a Product Key) to generate a

value is to determine if a file has been corrupted or tampered with during transmission over a network. In contrast, the purpose of the entitlement ID in the present invention is "for authorizing the installation of the software file." Many times the two are used together i.e. to ensure the transmitted message is not tampered with and a product key for authorizing the installation of software. However, the two are completely separate and different. Accordingly, independent claims 1, 9, 11, 12, 15, and 17 of the present invention distinguish over Kelley for at least this reason.

Continuing further, Kelley is completely silent on the entitlement process as recited in claims 1 and 12 of "matching the entitlement ID received with a request for the download copy" and claim 9 "verifying both the client system's PC compatibility for the requested copy of at least one software file and that the entitlement ID received from the ordering server matches the entitlement ID used to order the at least one software file" and claims 15, and 17 "that the entitlement ID received from the ordering server matches the entitlement ID used to order the at least one software file." Accordingly, independent claims 1, 9, 11, 12, 15, and 17 of the present invention distinguish over Kelley for at least this reason.

Continuing still further, in the present invention, the entitlement process for authorizing the use of the software is performed prior to any software for installation being downloaded to the client system. Rather, only software files where the entitlement ID from the order process matches the entitlement ID from the download process are delivered. This is different than Kelley where the checksum is used to verify that the correct file is on a target machine i.e. client machine requesting the patch. See Kelley paragraph 0075 *"unknown – The checksum of an object located within any of the patch specification files."* and Kelley at paragraph 0050 *"A cryptographic checksum for each file identification during the evaluation process described later."* The safe patch server is querying what is being installed on the client machine, not what checksum was

unique activation ID. The activation ID, along with the product key, is sent to the manufacturer to verify the authenticity of the product key and determine that the product key is not being used for multiple installations.

delivered from an order server during the client download process. Accordingly, independent claims 1, 9, 11, 12, 15, and 17 of the present invention distinguish over Kelley for at least this reason.

Independent claims 1, 9, 11, 12, 15, and 17 have been amended to distinguish over Kelley. Claims 2-8, 10 and 13-14 depend from independent claims 1, 9 and 12 respectively. Since dependent claims contain all the limitations of the independent claims, claims 2-8, 10 and 13-14 distinguish over Kelley as well and the Examiner's rejection should be withdrawn.

Rejection under 35 U.S.C. §103(a) as being unpatentable over Kelley in view of Smith

As noted above, the Examiner rejected claims 2 and 13 under 35 U.S.C. §103(a) as being unpatentable over Kelley et al (U.S. Publication 2002/0174422) in view of Smith et. al. (U.S. 6,067,582). Independent claims 1 and 12 have been amended to distinguish over Kelley taken alone and/or in view Smith. Further, as stated above Kelley has been removed as a reference under a properly filed 1.131 Affidavit. Accordingly, independent claims 1 and 12 distinguish over Kelley taken alone and/or in view Smith for at least this reason.

Continuing further, for the reasons stated above in the section entitled "(6-7) Rejection Under 35 USC § 102(e) In Light Of Kelley", independent claims 1 and 12 distinguish over Kelley taken alone and/or in view of Smith.

Continuing still further, the Examiner properly states that Kelley is silent on requesting acceptance of a software license agreement and goes on to combine Kelley with Smith.³

Smith specifically teaches creating embedding into the software application a specifically created agent module. This *teaches away* from the present invention where

³ Applicant makes no statement whether such combination is even proper.

the software file is downloaded and no changes to the vendors' software is needed. The present invention provides the advantages over the prior art of not requiring modification of the vendor software product. Specifically, this is unlike prior art solutions where the native installation of the software or the behavior of the software after it is installed must be altered. In contrast, the present invention teaches the use of specialized scripts for target client systems. The use of specialized scripts ensures that the software installation is standard across the enterprise. In turn, the use of standardized software along with automated installation reduces help desk costs. Accordingly, independent claims 1 and 12 distinguish over Kelley taken alone and/or in view of Smith for these reasons as well.

Claims 2 and 13 depend from independent claims 1 and 13 respectively. Since dependent claims contain all the limitations of the independent claims, claims 2 and 13 distinguish over Kelley in view of Smith as well and the Examiner's rejection should be withdrawn.

CONCLUSION

The remaining cited references have been reviewed and are not believed to effect the patentability of the claims as amended.

In this Response, the Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

Applicant acknowledges the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is

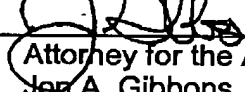
knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and his attorneys.

Applicant respectfully submits that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully Submitted,

Date: October 14, 2004

By: 

Attorney for the Applicant
Jon A. Gibbons
(Reg. No. 37,333)

Customer Number 23334
Fleit, Kain, Gibbons, Gutman,
Bongini & Bianco P.L.
One Boca Commerce Center, Suite 111
551 N.W. 77th Street
Boca Raton, FL 33487
Telephone No.: (561) 989-9811
Facsimile No.: (561) 989-9812

THIS PAGE LEFT BLANK